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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,334	03/17/2004	Cindy M. Lux	CL001-US	3731
24222	7590	12/23/2004	EXAMINER	
MAINE & ASMUS 100 MAIN STREET P O BOX 3445 NASHUA, NH 03061-3445			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/802,334	LUX, CINDY M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>22 October 2004</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 12 October 2004. No claims have been amended. The IDS statement filed 22 October 2004 has been entered and considered. Claims 1-29 remain pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18, 20-23, 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burko, U.S. Patent Application Publication 20020156672 A1, in view of Sugiyama, European Patent Application EP 0 696 006 A2 for the same reasons given in the previous Office Action (paper number 08262004). Further reasons appear hereinbelow.

(A) Claims 1-18, 20-23, 25-29 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08262004, section 3, pages 2-11), and incorporated herein.

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4. Claims 19, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burko, U.S. Patent Application Publication 20020156672 A1, and Sugiyama, European Patent Application EP 0 696 006 A2 as applied to claim 18 above, and further in view of Labelle et al., U.S. Patent Application Publication 20020120476 A1 for the same reasons given in the previous Office Action (paper number 08262004). Further reasons appear hereinbelow..

(A) Claims 19, 24 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08262004, section 4, pages 11-13), and incorporated herein.

***Response to Arguments***

5. Applicant's arguments filed 12 October 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response 12 October 2004.

(A) At pages 7-12 of the 12 October 2004 response, Applicant argues that the features in the application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Burko, Sugiyama and Labelle, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 08262004), and incorporated herein. In particular, Examiner notes that

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Burko, Sugiyama and Labelle teach " [t]he reception data processing means ...[...]. . . determines the identification number for a ...[...] ... patient ... [.] ... stores the ...[...]. . . date on which the validity of the insurance card was checked last time. . . ." and "[w]hen the new data agrees with the registered one, the validity of the health insurance card is verified (Sugiyama; column 3, lines 35-43, column 6, lines 50-51)." Examiner interprets this to read on "a data interface that enables the healthcare provider to form an electronic communication link with the payor to confirm the patient's eligibility for coverage by the payor, based on the identified insurance plan information." Also note, for example, that Sugiyama teaches providing "an automatic patient reception system that checks the validity of health insurance cards. . . without requiring human assistance" (Sugiyama; column 1, lines 42-46). Examiner interprets checking the validity of a health insurance card to mean confirming eligibility for insurance coverage.

With respect to Applicant's argument at paragraph 4 of page 7 of the 12 October 2004 response that the applied references fail to disclose "a patient's eligibility for coverage by the payor (insurance company) can be confirmed prior to the provider rendering service, [emphasis added]" Examiner notes that this limitation has not been recited in the claim language.

With respect to Applicant's argument at the paragraph bridging pages 7-8 of the 12 October 2004 response that the applied references fail to disclose "a data interface that enables the healthcare provider to confirm the patient's eligibility for coverage by the payor," Examiner notes that Figure 1 of Sugiyama shows the system of Sugiyama's invention, which is inclusive of multiple data interfaces, and which additionally includes communication means to external

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storage. Examiner interprets this system and communication means, together with the references cited above, as reading on these limitations.

With respect to Applicant's argument at the last paragraph on page 8 of the 12 October 2004 response that the Sugiyama reference fails to discuss "contacting the insurance company," Examiner notes that this limitation has not been recited in the claim language. Moreover, the Examiner respectfully submits that Applicant is not the first to invent contacting an insurance company to confirm a patient's eligibility for coverage. A system that includes contacting an insurance company to confirm a patient's eligibility for coverage was well established in the prior art, as, for example, shown by Burko, (see, for example, paragraph [0069]), and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

With respect to Applicant's argument at the first paragraph on page 9 of the 12 October 2004 response that the applied art fails to teach "wherein the data interface forms part of an electronic data interchange (EDI) between the healthcare provider and the payor," as recited in dependent claim 6, and "wherein the data interface operates in conjunction with the server and the billing system to form the electronic communication link between the healthcare provider and the payor," as recited in other dependent claims, Examiner respectfully disagrees. Electronic data interchange (EDI), or the exchange of standardized document forms between computer

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systems for business use, as well as the electronic communication link between the healthcare provider and the payor or insurance company, is clearly demonstrated in the applied art. (See, for example (Burko; see at least Figure 2, paragraphs [0039]-[0044], paragraphs [0058] -[0059], paragraph [0069]), (Sugiyama; see at least Figure 1, Figure 5)).

With respect to Applicant's argument at the second paragraph on page 9 of the 12 October 2004 response that the applied art fails to teach the limitations recited in dependent claims 27 and 28, Examiner respectfully disagrees. Burko teaches "[i]nformation relating to the appointment is provided at step 40. Such information may include fees/costs relating to the appointment or service, anything that should be brought to the appointment, any information relating to preparation for the appointment, and other such useful information. Further, as provided above, the customer is being prepared for or informed regarding the appointment in his/her desired language. A determination is then made at decision block 142 as to whether or not a prepayment is required. For example, the customer may or may not have an insurance policy that requires a co-payment" and "[f]urther, embodiments of the present invention embrace interfacing with a third party, such as interfacing with an insurance company or another entity for the payment for services provided, to exchange billing information, and the like," (Burko; see at least paragraphs [0058]-[0059], paragraph [0069]). Examiner interprets this, together with Figure 1, Figure 2, and Figure 7 of Burko, which display data interfaces, as reading on the recited limitations.

With respect to Applicant's suggestion at the paragraph bridging pages 9-10 of the 12 October 2004 response that the "patent rules of claim differentiation" state that two claims cannot be interpreted as having the same meaning, it is unclear to what section of MPEP Applicant refers. In the case of the two functional steps recited in claims 17 and 25, as there is no "additional" interface claimed, Examiner has given these claims their broadest reasonable interpretation and has cited appropriate references. Examiner further notes that it is evident that these two claims have not been interpreted as having the same meaning, as different references have been cited for the two claims.

In response to Applicant's arguments at pages 10-11 of the 12 October 2004 response against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge



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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (i) non-preferred embodiments of prior art must also be considered; and
- (i) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. Note, for example, page 4, lines 9-11 of the previous Office Action (paper number 08262004) which states "with the motivations of providing an automatic patient reception system that checks the validity of health insurance cards without requiring human assistance (Sugiyama; column 1, lines 42-46)" and page 12, lines 11-18 of the previous Office Action (paper number 08262004), which states "with the motivations of assisting potential purchasers of insurance... insurance companies (Labelle; see at least paragraph [0005])." As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

With regard to Applicant's disclosure in the last paragraph of page 12 of the 12 October 2004 response that "Applicant has reviewed the sections cited by the Examiner, and can find no occurrences..." Examiner notes that Applicant appears to rely upon only a small subset of Examiner's applied art. Further it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. **Any response to this final action should be mailed to:**

**Box AF**

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Commissioner of Patents and Trademarks

Washington D.C. 20231

**or faxed to:**

(703) 305-7687.

For formal communications, please  
mark "EXPEDITED PROCEDURE".

For informal or draft communications,  
please label "PROPOSED" or "DRAFT" on  
the front page of the communication and do  
NOT sign the communication.

Hand-delivered responses should be  
brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, Seventh Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

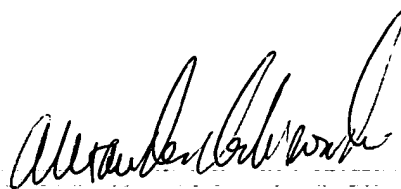
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9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

December 15, 2004



ALEXANDER KALINOWSKI  
PRIMARY EXAMINER